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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/080,474	02/22/2002	James R. Molnar	89190.146300/DP-302411	8464

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EXAMINER	
GANEY, STEVEN J	
ART UNIT	**PAPER NUMBER**
3752	

DATE MAILED: 03/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/080,474	MOLNAR, JAMES R.	
	Examiner	Art Unit	
	Steven J. Ganey	3752	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *04 October 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-9,11-19,24 and 25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-9,11-19,24 and 25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

1. Receipt is acknowledged of the amendment filed on October 4, 2004, which has been fully considered in this action.

Election/Restrictions

2. Applicant's election without traverse of claims 1-19 in the reply filed on February 19, 2004 is acknowledged.

3. Claims 20-23 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on February 19, 2004.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 3-9, 11-19, 24 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claims 1, 5, 18, 24 and 25, applicant recites "stabilized ferritic stainless steel", however, this is indefinite and is inconsistent since when looking to the specification, page 5, lines 6-12, "stabilized ferritic stainless steel" is defined to be a ferritic stainless steel comprising 12% to about 25% chromium, expressed in terms of weight percentage, then in lines 12-15,

"stabilized ferritic stainless steel" is again defined to be a ferritic stainless steel comprising at least one stabilizing element of titanium (Ti) and/or niobium (Nb) (also known as columbium (Cb)), in an amount up to about 1.5%, expressed in terms of weight percentage of each or both elements. This is further reinforced with the limitation in claims 15, 17, 24 and 25 ,where stabilized ferritic stainless steel is defined to be a combination of chromium and at least one element selected from the group consisting of titanium and columbium or is defined to be a stabilized ferritic stainless steel including titanium or columbium.

Therefore, the claims are indefinite since the metes and bounds of the claims cannot be determined in light of applicant's arguments concerning "solenoid-quality stabilized ferritic stainless steel". While applicant is entitled to be his or her own lexicographer, the applicant is inconsistent and is not clear which definition defines "stabilized ferritic stainless steel" and therefore one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

6. Note in the following rejection, the claim has been given its broadest reasonable interpretation consistent with the specification and broadest reasonable interpretation of the claim consistent with the interpretation that those skilled in the art would reach. The words of the claim have been given their plain meaning. Although applicant has attempted to define "solenoid-quality stabilized ferritic stainless steel" in the specification and in the claims, the applicant has not provided a clear definition and has been inconsistent, as discussed above in paragraph 5. Reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from reading limitations of the

specification into a claim, to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim. Therefore the examiner considers a "solenoid-quality stabilized ferritic stainless steel" to be defined as a ferritic stainless steel(i.e. a stainless steel that is magnetic) that has a quality to be used in solenoids(i.e. if it is used in a solenoid then it is inherent that the stainless steel is solenoid-quality) and is stabilized(i.e. it is stable and therefore resists chemical change or will not corrode).

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kosa et al.

Luttrell et al discloses a solenoid valve comprising a plurality of components 24 and 26 formed of ferritic stainless steel, see col. 6, lines 36-39 and 43-44, which have the quality to be used in the solenoid valve, and being stainless components they are resistant to corrosion therefore they are stabilized.

9. Note in the rejections that follow it is assumed, arguendo, that the applicant is entitled to be his or her own lexicographer, per the arguments, and rebuts the presumption that claim terms are to be given their ordinary and customary meaning by clearly setting forth a definition of the phrase "solenoid-quality stabilized stainless steel", as defined in the arguments and specification.

Therefore, in response to applicant's arguments, the scope of claims is considered changed since applicant has set forth the definition of the phrase "solenoid-quality stabilized stainless steel".

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claim1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kosa et al.

Kosa et al discloses a solenoid-quality stabilized ferritic stainless steel which can be used in components used for solenoid valves, see col. 5, lines 3-10.

12. Claim1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Honkura et al.

Honkura et al discloses a solenoid-quality stabilized ferritic stainless steel which can be used in components used for solenoid valves, see col. 1, lines 9-11.

13. Claim1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by DeBold et al.

DeBold et al discloses a solenoid-quality stabilized ferritic stainless steel which can be used in components used for solenoid valves, see col. 6, lines 7-13.

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

15. Claims 1, 3-9, 11-13, 15-19, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Luttrell et al in view of Kosa et al.

Luttrell et al discloses a fuel injector assembly and electric solenoid valve comprising a plurality of components 24 and 26 formed of solenoid-quality ferritic stainless steel, see col. 6, lines 36-39 and 43-44, which are adjacent and joined by laser welding, see, col. 7, lines 39-41, an electric solenoid actuator 18/22/28/30'; a solenoid-quality ferritic stainless steel injector body 14; a solenoid body 24; fuel tube 16 formed of austenitic stainless steel(i.e. 304 stainless steel) welded to injector body 14, see col.5, lines 10-36; and coil body 24 formed of solenoid-quality ferritic stainless steel, except for the ferritic stainless steel being "stabilized" ferritic stainless steel as argued by the applicant. Note that Luttrell et al discloses that other ferritic steels can be used, besides 430 stainless or 430F stainless steels, see col. 5, line 2 and line 65 and col. 6, line 22 and lines 38 and 39. Kosa et al discloses a solenoid-quality stabilized ferritic stainless steel alloy that can be used in components for solenoid valves and components of fuel injection systems, see col. 5, lines 5-10. Note that the solenoid-quality stabilized ferritic stainless steel alloy of Kosa et al comprises 15-20% chromium in weight percentage, titanium up to 0.51% in weight percentage, see Table 1 and up to .34% columbium/niobium in weight percentage. It would have been obvious to one having ordinary skill in the art at the time the invention was made to substitute the ferritic stainless steel alloy of Kosa et al for the ferritic stainless steel alloy of Luttrell et al since Luttrell et al discloses that other ferritic steels may be used and since Kosa et al teaches that the stabilized ferritic stainless steel of Kosa et al has better corrosion resistance and is an easily machinable alloy compared to Type 430F ferritic stainless steel as disclosed in

Luttrell et al. Such a stabilized ferritic stainless steel used in Luttrell et al, as taught by Kosa et al, would perform equally as well in the apparatus of Luttrell et al.

As to claims 7-9, see col. 3, lines 33-57.

Allowable Subject Matter

16. Claim 14 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Response to Arguments

17. Applicant's arguments filed October 4, 2004 have been fully considered but they are not persuasive.

Applicant argues that in claim 1 Luttrell et al does not teach or suggest an electric solenoid formed of solenoid-quality stabilized ferritic stainless steel and that the stainless steel of Luttrell et al does not include a stabilizing element. Note in that in the rejection of claim 1, the claim has been given its broadest reasonable interpretation consistent with the specification and broadest reasonable interpretation of the claim consistent with the interpretation that those skilled in the art would reach. The words of the claim have been given their plain meaning. Although applicant has attempted to define "solenoid-quality stabilized ferritic stainless steel" in the specification and in the claims, the applicant has not provided a clear definition and has been inconsistent, as discussed above in paragraph 5. Reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is a quite different thing from reading

limitations of the specification into a claim, to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim. Therefore the examiner considers a "solenoid-quality stabilized ferritic stainless steel" to be defined as a ferritic stainless steel(i.e. a stainless steel that is magnetic) that has a quality to be used in solenoids(i.e. if it is used in a solenoid then it is inherent that the stainless steel is solenoid-quality) and is stabilized(i.e. it is stable and therefore resists chemical change or will not corrode).

Also, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., stabilizing element) are not recited in the rejected claim. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

18. Applicant's arguments with respect to claims 1, 3-9, 11-13, 15-19, 24 and 25 have been considered but are moot in view of the new grounds of rejection.

Note in the rejection claims 1, 3-9, 11-13, 15-19, 24 and 25 it was assumed, arguendo, that the applicant is entitled to be his or her own lexicographer, per the arguments, and rebuts the presumption that claim terms are to be given their ordinary and customary meaning by clearly setting forth a definition of the phrase "solenoid-quality stabilized stainless steel", as defined in the arguments and specification. Therefore, in response to applicant's arguments, the scope of claims is considered changed since applicant has set forth the definition of the phrase "solenoid-quality stabilized stainless steel".

Conclusion

19. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

20. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven J. Ganey whose telephone number is (571) 272-4899. The examiner can normally be reached on Monday, Tuesday, Wednesday, and Thursday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dave Scherbel, can be reached on (571) 272-4919. The fax phone number for this Group is (571) 273-8300.

STEVEN J. GANEY
PRIMARY EXAMINER
3/16/06

sjg

3/16/06